

and other heterologous promoters or regulator elements are not necessary. Withdrawal of this rejection is therefore requested.

The Examiner has rejected claims 1-22 under 35 U.S.C. §112, first paragraph, as containing subject matter which was "not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention". Applicant submits that the specification provides adequate information to enable a person of ordinary skill in the art to make and/or use the invention. The native regulatory element(s) already present in the donor DNA are sufficient and other heterologous promoters or regulatory elements are not needed. Applicant submits herewith Declarations under 37 CFR §1.132 by Herbert M. Wilson and Harry H. Stine which show the subject matter was described in the specification in such a way as to enable one skilled in the art to make and use the invention. Withdrawal of this rejection is therefore requested.

The Examiner has rejected claims 1-2 and 8-9 under 35 U.S.C. §102(b) as being anticipated by Masoud et al. Claim 1 has been amended to indicate "uncharacterized" DNA. Accordingly, withdrawal of this rejection is respectfully requested.

The Examiner has rejected claims 1-22 under 35 U.S.C. §103 as being unpatentable over Masoud et al. in view of Hamilton et al. Claim 1 has been amended to state "uncharacterized" DNA. The intent of Hamilton et al. is to characterize the donor DNA. The present invention does not involve a method of characterization prior to or after transformation. Applicant submits that the cited references, when viewed separately or in combination, do not teach or suggest the claimed invention. Accordingly, withdrawal of this rejection is respectfully requested.

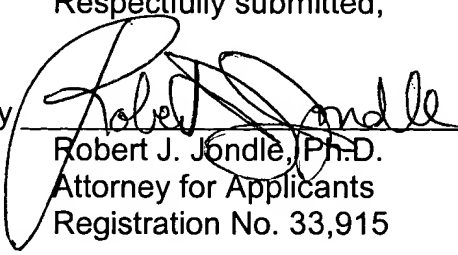
Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "**Version with markings to show changes made**".

In view of the above amendments and remarks, it is submitted that the present claims satisfy the provisions of patent statutes and are patentable over the prior art.

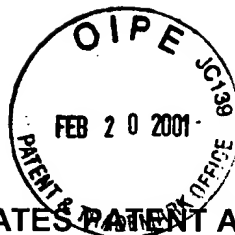
Reconsideration of this application and early notice of allowance is respectfully requested.

Respectfully submitted,

By


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PATENT
ATTY. DOCKET #N1205-003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Herbert M. WILSON, et al.
Serial No.: 09/140,886
Filed: August 26, 1998
Group Art Unit: 1649
Examiner: O. Zaghmout
For: TRANSGENIC PLANTS

VERSION WITH MARKINGS TO SHOW CHANGES MADE

1. (AMENDED) A method for obtaining a transgenic plant ~~having an improved agronomic characteristic~~ which comprises:

- (a) preparing uncharacterized DNA fragments from DNA of a donor plant species;
- (b) transforming plant cells of a recipient plant species with said DNA fragments;
- (c) selecting transformed plant cells;
- (d) regenerating plants from the transformed plant cells;
- (e) harvesting seed from the regenerated plants;
- (f) planting the harvested seed and growing the resultant plants;
- (g) analyzing the plants for improved agronomic characteristics; and
- (h) selecting plants having an improved agronomic characteristic.

15. A method for obtaining a transgenic plant ~~having an improved agronomic characteristic~~ which comprises:

- (a) preparing uncharacterized DNA fragments from DNA of a donor plant species;
- (b) inserting said DNA fragments into a vector;
- (c) transforming plant cells of a recipient plant species with said vector containing said DNA fragments;
- (d) selecting transformed plant cells;
- (e) regenerating plants from the transformed plant cells;
- (f) harvesting seed from the regenerated plants;
- (g) planting the harvested seed and growing the resultant plants;
- (h) analyzing the plants for improved agronomic characteristics;
- (i) selecting plants having an improved agronomic characteristic;
- (j) harvesting seed from said selected plants; and
- (k) introducing seed from said selected plants into a breeding program to produce progeny of said plants, said progeny maintaining said improved agronomic characteristic.